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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,308	07/11/2001	Masayuki . Chatani	37090-6062	1011
33123	7590	04/07/2006	EXAMINER	
HELLER EHRMAN LLP 4350 LA JOLLA VILLAGE DRIVE #700 7TH FLOOR SAN DIEGO, CA 92122			NGUYEN, PHUOC H	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/903,308	<b>Applicant(s)</b> CHATANI ET AL.	
	<b>Examiner</b> Phuoc H. Nguyen	<b>Art Unit</b> 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Amendment received on November 10, 2005 has been entered into record.

### ***Response to Amendment***

3. This office action is in response to the applicants Amendment filed on November 10, 2005. Claims 1, 16, 30, 44, 58, and 72 have been amended. Claims 1-89 are presented for further consideration and examination.

### ***Response to Arguments***

4. Applicant's arguments filed 11/10/2005 have been fully considered but they are not persuasive.

The applicant argues in page 21 second paragraph for claims rejected under 102 that the cited reference by Sahai fails to disclose a limitation "predefined service levels that set combinations of transfer" as seen in the claimed invention.

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The examiner respectfully submits that Sahai clearly discloses in the Patent No. 6,594,699 a method of optimizing download multimedia content over internet to the client from server based upon the client's references and particularly capabilities (e.g. col. 1 line 60 to col. 2 line 34 and col. 3 line 25 to col. 4 line 65). Upon receiving the user or client's references and capabilities (e.g. manually or automatically), the server will determine and select appropriated parameters for delivering multimedia content to the clients (e.g. col. 4 lines 40-65). These appropriated parameters are well-defined as software and/or hardware decoders, type of media, network parameter as bit rate, load balancing..., and application residing (e.g. col. 4 lines 40-65). The server specifically determines and select the appropriated media type and correct bit rate to use when delivering content to the client (e.g. col. 6 lines 30-45). Given the same references and same capabilities of client, the server will and absolutely will provide the same appropriated parameters as defined above. Thus, the service levels or grouping of appropriated parameters must be or inherently predefined or algorithm determined in the server.

Further, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Sahai leaves control of presentation parameters to the content server rather than the content provider as seen in the pending claims) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-12,16-18,23-40,44-46,51-68, and 72-74 are rejected under 35 U.S.C. 102(e) as being anticipated by Sahai et al. (Hereafter, Sahai) U.S. Patent 6,594,699.

7. Regarding claims 1,30, and 58, Sahai's figure 1 discloses a method of managing the Transfer of content to a user device that is communicatively linked to a computer network, comprising: obtaining user device information descriptive of a configuration of the user device (col. 2 lines 61-64; and col. 5 lines 5-6); determining capabilities of the user device to download content over the network and to process content received over the network based upon the user device information (col. 5 lines 5-14); automatically selecting a service level that is selected from among a plurality of predefined service levels and is determined to be available to the user device for transferring content thereto based upon the determined capabilities of the user device, wherein the selected service level is associated with one or more characteristics of content for transfer to the user device (col. 4 lines 32-63; and col. 6 lines 12-49).

8. Regarding claims 2,17,31,45,59, and 73, Sahai further discloses receiving a request to transfer content to the user device over the computer network, and causing content to be transferred to the user device over the network according to the selected service level (Figure 2,

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and col. 6 lines 12-49).

9. Regarding claims 3,32, and 60, Sahai further discloses a service level is also associated with one or more characteristics of the manner in which content is transferred to the user device over the network (col. 5 lines 7-26).

10. Regarding claims 4, Sahai further discloses identifying a list of content that can be transferred to the user device based upon the determined capabilities of the user device, and causing the list of content to be displayed at the user device (col. 6, lines 12-23).

11. Regarding claims 5,23,33,51,61, and 79, Sahai further discloses the user device information includes the amount of data (e.g. bit rate) that can be transmitted to the user device in a given amount of time over the network (col. 6 lines 12-49).

12. Regarding claims 6,24,34,52,62, and 80, Sahai further discloses the user device information includes the latency of the user device with respect to a content provider device on the computer network (col. 6 lines 12-49).

13. Regarding claims 7,25,35,53,63, and 81, Sahai further discloses the user device information includes the amount of data storage capacity available to the user device (col. 3 lines 23-60).

14. Regarding claims 8,26,36,54,64, and 82, Sahai further discloses the one or more characteristics of content associated with a service level includes the size of the content (col. 4 lines 9-31).

15. Regarding claims 9,27,37,55,65, and 83, Sahai further discloses the one or more characteristics of content includes whether the content includes graphic files (col. 4 lines 9-31).

16. Regarding claims 10,28,38,56,66, and 84, Sahai further discloses the one or more

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characteristics of content includes whether the content is art executable file (e.g. Java) (col. 6 last paragraph through col. 7 1<sup>st</sup> paragraph).

17. Regarding claims 11,29,39,57,67, and 85, Sahai further the manner in which the content is transferred to the user device comprises streaming the content to the user device (Abstract).

18. Regarding claims 12,18,40,46,68, and 74, Sahai further discloses a first service level has a corresponding minimum capabilities requirement, and further comprising selecting a first service level for the user device only if the capabilities of the user device meet the minimum capabilities requirements (col. 6 lines 35-49).

19. Regarding claims 16,44, and 72, Sahai further discloses obtaining user device information descriptive of a configuration of the user device (col. 2 lines 61-64; and col. 5 lines 5-6); identifying one or more service levels that may govern the transfer of content to the user device, wherein each service level is associated with one or more characteristics of content available for transfer to the user device and the manner in which content is transferred to the user device over the network, each service level being further associated with minimum requirements relating to the configuration of the user device, making available at least one of the service levels to the user device for governing the transfer of content to the user device (col. 5 lines 5-14; and col. 6 lines 35-49); automatically selecting a service level to govern the transfer of content to the user device based upon the user device information (col. 6 lines 12-49).

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 13-14,19-21,41-42,47-49,69-70, 75-77, and 86-89 are rejected under 35 U.S.C.

103(a) as being unpatentable over Sahai in view of Lipa et al. (Hereafter, Lipa) U.S. Patent 6,061,722.

22. Regarding claims 13-14,19-21,41-42,47-49,69-70, and 75-77, Sahai reference discloses selecting a service level for user device based upon the capabilities of the client device; however, Sahai fails to teach if the capabilities of the user device do not meet the minimum capabilities requirement of the first service level, determining an upgrade that could provide a different service level, and notifying the user device of the upgrade, and notifying the user device of changes that may be made to the configuration of the user device in order to upgrade the capabilities of the user device.

Lipa reference teaches first service level, determining an upgrade that could provide a different service level, and notifying the user device of the upgrade, notified the user, and gave user suggestion that may be made to the configuration of the user device (col. 2 lines 30-45).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Lipa's teaching into Sahai's method to determine an upgrade that could provide a different service level, and notifying the user device of the upgrade, and provide suggestion what need to be changed that may be made to the user device configuration in order to improve the network connection.

23. Regarding claims 86-89, Sahai reference discloses selecting a service level for user device based upon the capabilities of the client device; however, Sahai fails to teach selecting a



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service level is performed at a network service manager device independent of a network provider from which the content is transferred.

Lipa reference teaches selecting a service level is performed at a network service manager device (e.g. operations center) independent of a network provider (e.g. servers 127, 129, 114, or 115) from which the content is transferred (Figures 1 and 3; col. 4 lines 1-7; col. 5 lines 7-14; and col. 6 lines 57 through col. 7 lines 37).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Lipa's teaching into Sahai's method to selecting a service level is performed at an operation center independent of a server from which the content is transferred, so the operation center can determine which of the plurality of zones (e.g. server) is likely to provide the best connection for the user.

24. Claims 15,22,43,50,71, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sahai and Lipa in view of Hubbard U.S. Patent 6,654,783.

Sahai and Lipa discloses first service level, determining an upgrade that could provide a different service level, and notifying the user device of the upgrade, and provide suggestion what need to be changed that may be made to the user device configuration; however, Sahai and Lipa fail to teach sending one or more advertisements to the user device regarding changes that may be made to the configuration of the user device.

Hubbard teaches sending one or more advertisements to the user device regarding changes that may be made to the configuration of the user device (col. 9, last paragraph).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Hubbard's teaching into Sahai and Lipa's method to provide

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advertisements to the user device regarding changes that may be made to the configuration of the user device in order to attract the user attention.

### *Conclusion*

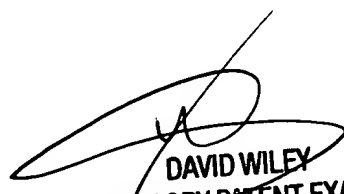
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuoc H Nguyen  
Examiner  
Art Unit 2143

March 29, 2006

  
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